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IN THE

Supreme Court of the United States

October Term, 1941.

No. 991.

EDWIN L. WIEGAND COMPANY and EDWIN L. WIEGAND,
Petitioners,

v.

HAROLD E. TRENT COMPANY and HAROLD E. TRENT,
Respondents.

Brief for Respondents in Opposition to Petition for Writ of Certiorari.

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For Respondents.

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BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOREWORD.

This is an ordinary patent case. There is no conflict of decisions between courts of appeal of different circuits and no other reasons such as those set forth in Rule 38, Sect. 5, for granting of the writ of certiorari.

The petition is directed solely to the issue of validity of claims 1, 3, 5, 8, 9 and 12 of Wiegand Patent No. 1,614,330 after disclaimer. The patent was held invalid before disclaimer by the District Court because of anticipation and for want of invention in view of the prior patented art (R-31). On rehearing, after disclaimer, the District Court again held the patent invalid as anticipated and for want of invention over the prior art (R-52).

The Circuit Court of Appeals affirmed (R-64-68) and denied rehearing (R-68).

Neither the District Court nor the Circuit Court of Appeals passed on the question of infringement of the patent after the disclaimers were entered therein.

ARGUMENT.

I.

There Is No Conflict of Opinion.

(a) The Circuit Court of Appeals for the Sixth Circuit, in the Wiegand v. Cutler-Hammer case, did not pass on the question of validity of the patent.

The petition itself admits this, stating that the decree (Exhibit D-68) was "affirmed on appeal, but without passing on the holding of validity" (petition, page 7 as corrected). In addition see the opinion of the Sixth Circuit Court of Appeals (R-228).

Thus it is plain from the petition and the opinion that there is no conflict between decisions of Courts of Appeal.

Even as to the opinion of the District Court in the Cutler-Hammer case, there is no real basis for saying that the patent was held valid, for the basis of the decision was non-infringement.

As Judge Kirkpatrick stated with respect to that opinion: "the question of the validity of the patent as thus narrowed was not directly in issue" (R-28), and this is fully borne out by a reading of the opinion in question (R-221-223).

The *decree* of the District Court in the Cutler-Hammer case purported to adjudicate the validity of the patent (R-225). But since the cause was disposed of on the ground of non-infringement this purported adjudication was immaterial to the disposition of the cause and should not have been embodied in the decree. *Electrical Fittings Corporation v. Thomas and Betts Company*, 307 U. S. 241-2 (decided after date of entry of the Cutler-Hammer decree).

(b) Even if it be assumed that the Courts of the Sixth Circuit had ruled on validity of the patent there is still no conflict of opinion. The patent finally held invalid by the Courts of the Third Circuit was not the same patent as that considered in the Sixth Circuit for it had been extensively modified by disclaimers.

In *Altoona Publix Theatres v. American Tri-Ergon Corporation,* 294 U. S. 477, 492, this Court stated:

> "The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or hold by virtue of the patent'. Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned."

Thus, as to the four claims in which disclaimers were entered there can be no question that the original claims, before disclaimer, are no longer in existence. They are "withdrawn from the protection of the patent law", and the patent as considered in the Third Circuit was to that extent not the same as the patent considered in the Sixth Circuit.

Claims 8 and 9, in which no disclaimers were entered, are likewise affected, for the disclaimers affect the whole patent. The disclaimers are a confession that the patentee in the claims in which they were entered claimed "more than that of which he was the original or first inventor or discoverer" (*Maytag v. Hurley Machine Co.,* 307 U. S. 243) and this "confession" applies not only to the claims in which the disclaimers were entered but to the whole patent.

Claims 8 and 9 cannot escape the consequences of the confession involved in the disclaimers to the other claims. They are directed to the same article as the four claims in which disclaimers were entered and embody the substance of what was set forth in claims 1, 3 and 5 before disclaimer. Claims 8 and 9 elaborate in particulars but the fundamental combination of elements of original claims 1, 3 and 5 is the fundamental combination of claims 8 and 9. The disclaimers to claims 1, 3 and 5 necessarily, therefore, must be given effect in construing claims 8 and 9, and when thus given effect the claims are no longer the same.

(Note—It is our position that the whole patent is invalid under the ruling of *Maytag v. Hurley,* supra, but we cite the case here only on the point that the disclaimer involved a confession that the patentee claimed more than he invented.)

The same conclusion must follow from *Altoona Publix Theatres v. American Tri-Ergon Corporation,* supra, for if subject matter of the original claims is withdrawn from the protection of the patent law and the public is entitled to manufacture and use the device originally claimed, then the scope and interpretation of other claims must necessarily be affected, and this especially when, as here, the substance of the two claims in question consists of what was disclaimed in others.

(c) Finally, there is no conflict of opinion because the patents most relied on in the Third Circuit (Muller and Luftfahrzeugbau) were not, as Judge Kirkpatrick pointed out—R-28), before the Court in the Cutler-Hammer case in the Sixth Circuit. Judge Kirkpatrick, in both opinions, held the claims to be anticipated by these patents (R-28 and 52) and the Court of Appeals affirmed (R. 68).

The Cutler-Hammer case was, therefore, decided on evidence which differed in essentials from that on which the case was decided in the Third Circuit, and in such circumstances there could be no conflict.

* * * * * *

Petitioners also contend "that the holding of invalidity is in conflict with the prevailing recognition of the invention". (Petition p. 7.) This argument is based on supposed commercial success and recognition in one form or another.

Evidence to establish commercial success and recognition is present in patent cases almost without exception. But such evidence is without significance on the question of novelty, *Toledo Pressed Steel Co. v. Standard Parts,* 307 U. S. 350, 356, 357, and the patent here involved was held to be anticipated, i. e., lacking in novelty.

Even on the question of invention, commercial success and recognition are given weight only when invention is in doubt, *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U. S. 477, 488, and cases there cited, and may not be used to create a doubt as well as to resolve it. *Republic Rubber Co. v. G. & J. Tire Co.,* 212 Fed. 170, 172 (C. C. A. 7).

Obviously, therefore, commercial success and recognition should not be dignified to the extent that they counterbalance the weight of a well considered judgment of a competent court to create a "conflict", and this especially where the patent was held to be anticipated as well as wanting in invention.

If testimony as to commercial success and recognition serve as the basis of creating a "conflict" justifying the

grant of a writ of certiorari, most of the cases where the patent is held invalid would come to this Court.

II.

Petitioners contend (Petition pp. 8-9) that the holding of invalidity is predicated on an interpretation of the invention, different from the invention as defined by the claims.

This is based on the assumption that no consideration was given to the claims of the patent for the reason that the Court of Appeals made a brief general statement as to what was involved in the invention * (R-62) and did not quote the claims in full.

Cases are cited to the point that the claims must be turned to in seeking to determine what the invention is. That of course is elementary and to say that the Court did not do so, solely because the claims were not quoted, is nothing more than unwarranted speculation implying that the Court failed in its duty.

III.

Petitioners' third argument (Petition pp. 9-13) boils down to a contention that foreign patents to Muller and Luftfahrzeugbau do not disclose what the lower Courts found them to disclose and that they are, therefore, not adequate, under the law to support a judgment of invalidity of the patent in suit on the grounds of anticipation or want of invention.

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* It is interesting to note that petitioners' witness Calhoun in answer to a question as to what the Wiegand units in general comprised, answered "a resistor wire, embedded in a refractory, and sheathed in a metal sheath", (R-71, Q. 16 and Answer)—language almost identical with that used by the Court in giving the brief general description of the invention.

The District Court in its first opinion, on the very basis of "plaintiffs' testimony" (R-28) and a careful study of the disclosures of the foreign patents (R-27), found that they disclose what petitioners deny they do and that they anticipate.

In the second opinion, after rehearing in which plaintiff Wiegand elaborated on his testimony as to these foreign patents, the District Court stated: "After full consideration, I reaffirm my conclusion that the '330 patent is invalid as anticipated, and state an additional conclusion that, if not fully anticipated, it is invalid for want of invention over the prior art." (R-52.)

In both opinions ample support in the record for the findings is referred to.

The Court of Appeals did not disturb these findings.

Petitioners' whole argument, therefore, is based, not on any conflict of the decision with applicable law, but on contention of inadequacy of the patents because of a quarrel with the lower Courts as to what the patents disclose.

This is a question of fact and this Court does not grant writs of certiorari "merely to review the evidence or inferences drawn from it." Nor to review questions of anticipation and invention unless there is a conflict between decisions of Circuit Courts of Appeal. *General Talking Pictures Corp. v. Western Electric Company,* 304 U. S. 175, 178.

(As pointed out above (pp. 4, 5) there is no such conflict here for the foreign patents in question were not before the Court in the Sixth Circuit.)

Another complete answer to the whole argument lies in the fact that the patent in suit was held invalid for want

of invention over the prior art generally (R-52) and this prior art includes many United States patents, e. g. Hadaway, No. 1,150,426 (referred to by the District Court R-26), and Lightfoot, No. 1,403,331, which are just as effective as the foreign patents on this score.

IV.

Petitioners' fourth argument (Petition pp. 13 to 17) is to the point that the alleged improvement was not obvious to those skilled in the art and therefore involved invention.

The first answer to this is that the District Court in both opinions, in addition to finding no invention, held the patent invalid as *anticipated* (R-28 and 31, and R-52) and this was not disturbed on appeal. In order to anticipate or to negative novelty—

> "it is necessary that all of the elements of the invention or their equivalents be found in one single description or structure where they do substantially the same work in substantially the same way."
>
> *Walker on Patents*—Deller Edition, Vol. I, page 255, and cases there cited.

and petitioners completely ignore the finding of the Court that there was anticipation.

However, even on the question of *invention*, petitioners again ask this Court to review the case not because of any conflict with established law but solely on the ground of the application of the law to the facts of this case.

There are many cases to the effect that the substitution of one well known material for another does not involve invention.

Terhune v. Phillips, 99 U. S. 592;
Brown v. District of Columbia, 130 U. S. 87;
Florsheim v. Schilling, 137 U. S. 64;
American Fruit Growers v. Brogdex, 283 U. S. 1, 14.

and even if it be assumed that Muller and Luftfahrzeugbau disclosed nothing more than mica the only question is whether the substitution of a well known electrical insulating material in place of the mica involved invention. In finding that it did not, the lower Courts merely applied a well established rule of law to the facts of this case and this does not provide a reason for the granting of a writ of certiorari.

That the precise material used by defendant (aluminum oxide), was well known for the very purpose in this heater art as early as 1910, is explained by petitioner Wiegand himself in a letter, Exhibit D-67 (R. 224a and 224b), written in 1922, in which he states:

> "The only patent which the Dover Company has is the one attempting to cover the use of aluminum oxide granules with a ceramic bond for heater insulation purposes.
>
> "This is none other than 'Alundum Cement,' which was originated and sold on the market by the Norton Company of Worcester, Mass., as early as 1910.
>
> "Therefore the material which they intend to cover was not only the work of other people, but their patent is invalid, because of the length of time this material has been known in the heater art.
>
> "The patent you refer to was issued in 1920 I believe and I knew this material and made elements of it myself as early as 1911."

CONCLUSION.

There is no conflict of decision between Circuit Courts of Appeal.

The other grounds set forth in the petition raise only questions of the application of the law to the particular facts of this case and are of interest only to the parties. As Mr. Chief Justice Hughes pointed out in his remarks at the American Law Institute meeting, as reported in the June, 1934, issue of the American Bar Association Journal:

> "That review (by writ of certiorari) is in the interest of the law, not in the interest of particular parties."

The petition should be denied.

Respectfully submitted,

HARVEY L. LECHNER,
EDWARD H. DAVIS,
For Respondents.

March, 1942.